

**REMARKS**

Claims 1, 3 and 5-52 are all the claims pending in the application. Claims 2 and 4 are cancelled by this Amendment. Claims 17-20 have been objected to because of grammatical errors in the claims. Claims 3, 33-36, 40, 51 and 52 have been rejected under 35 U.S.C. § 101. It also appears that claim 1 may have been rejected under 35 U.S.C. § 101. Claims 1, 2, 5, 11, 13, 15, 17-19, 21-39, 41-42 and 47-52 have been rejected under 35 U.S.C. § 112, second paragraph. Claims 1-4, 11-13, 15, 18-20, 22-24, 26-28, 31-32, 34-45 and 47-52 have been rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,039,430 Helterline *et al.* ("Helterline"). Claims 5-10, 16-17, 21, 25, 29, 30, 33 and 46 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Helterline in view of U.S. Patent No. 6,039,430 to Archer ("Archer"). The Examiner has indicated that claim 14 is rejected in the Office Action Summary, but has not specifically rejected claim 14 in the Office Action.

**ALLOWABLE SUBJECT MATTER**

As the Examiner has not provided any basis for rejecting claim 14, Applicant requests that the Examiner indicate that claim 14 is allowable in the next Office Action.

**AMENDMENTS TO THE CLAIMS**

Independent claims 1 and 3 have been amended to incorporate the limitations of claims 2 and 4, respectively.

Claims 33-36 and 51-52 have been amended to more thoroughly define the present invention.

Claims 5-20, 25-28 and 42-46 have been amended to correct minor typographical and punctuation errors. As these amendments are editorial amendments, Applicant submits that these amendments do not narrow the literal scope of the claims and, thus, do not implicate an estoppel in the application of the doctrine of equivalents. The amendments to claims 5-20, 25-28 and 42-46 were not made for reasons of patentability.

### **OBJECTIONS TO THE CLAIMS**

Claims 17-20 have been objected due to a grammatical errors in the claims. Applicant has amended claims 17-20 as suggested by the Examiner. Applicant submits that these amendments overcome the Examiner's objections.

### **35 U.S.C. § 101 REJECTIONS**

Claims 1, 3, 33-36, 40, 51 and 52 have been rejected under 35 U.S.C. § 101.

#### **1. Claims 1, 3 and 40**

The Examiner has rejected claims 1, 3 and 40 as not being within the technological arts.

Claim 1 recites an image-forming system (i.e., a manufacture) with a variety of components. A manufacture is statutory subject matter under 35 U.S.C. § 101. Furthermore, image-forming systems fall within the technological arts. Accordingly, Applicant requests that the Examiner withdraw his rejection of claim 1. Applicant notes that the Examiner has not listed claim 1 in his recitation of rejected claims, but has listed claim 1 as not being within the technological arts. Therefore, the Examiner's rejection of claim 1 may be a typographical error on the Examiner's part, and, if so, Applicant's comments with respect to claim 1 are moot.

Claims 3 and 40 recite a method for providing a benefit and a cartridge recovery method, respectively. The Examiner asserts that because no structural limitations are provided (i.e., computer implementation), the claimed subject matter fails outside of the scope of the technological arts. However, under 35 U.S.C. § 101, “any new and useful process” is patentable. The methods of claim 3 and 40 fall within the technological arts. Therefore, Applicant submits that the Examiner’s rejection of claims 3 and 40 is improper.

**2. Claims 33-36 and 51-52**

Claims 33-36 and 51-52 have been rejected as reciting functional descriptive material, i.e., a program *per se*. However, as amended, claims 33-36 and 51-52 recite a computer program product, i.e., a manufacture under 35 U.S.C. § 101. Applicant submits that these claims recite statutory subject matter that falls within the technological arts. Therefore, Applicant requests the Examiner to withdraw his rejection.

**35 U.S.C. § 112 REJECTIONS**

Claims 1, 2, 5, 11, 13, 15, 17-19, 21-39, 41-42 and 47-52 have been rejected under 35 U.S.C. § 112, second paragraph. The Examiner has indicated that numerous claim elements lack the proper antecedent basis. However, a review of the rejected claims confirms that each element allegedly lacking the appropriate antecedent basis has been appropriately introduced into the claims. For example, looking at claim 1, the Examiner has objected to the claim element “from the memory element” (claim 1, line 4) as lacking a proper antecedent basis. However, “a removable cartridge possessing a memory element” is introduced in the preamble to claim 1 (claim 1, lines 2-3) (emphasis added). Accordingly, Applicant submits that it is not necessary to

amend claim 1 to overcome the Examiner's rejection. The Examiner's rejections of the remaining claims also appear to be improper for analogous reasons. Therefore, Applicant submits that no amendments are necessary to overcome the Examiner's 35 U.S.C. § 112 rejections.

**35 U.S.C. § 102 REJECTIONS**

Claims 1-4, 11-13, 15, 18-20, 22-24, 26-28, 31-32, 34-45 and 47-52 have been rejected under 35 U.S.C. § 102(e) as being anticipated by Helterline.

**1. Claims 1 and 3**

Helterline discloses an ink jet printing system 10 having a printer 12 with a plurality of removable printing components 14 (printheads 16 and ink containers 18). Figs. 1 and 2A. Each of the replaceable printing components includes a memory 38 related to the respective replaceable component 14. Col. 4, lines 7-12. Memories 38 are connected to controller 26. Col. 4, lines 23-26. Controller 26 is connected to a host computer 28. Fig. 3. During operation, information stored on information storage devices 38, i.e., operational parameters (see col. 6, lines 1-8), are read by controller 26 (step 64 of Fig. 4). The operation of printer 12 is adjusted based on the reading of these operational parameters. Col. 6, lines 1-8; col. 5, line 65-col. 6, lines 14.

The Examiner appears to admit, however, that Helterline does not disclose an image-forming system "wherein the information read is one of user support information, or a URL of a site, on a communications network" possessing the user support information; and [wherein] the executing component executes processing for supporting the user based on the read

information.” However, the rejection is unclear. Regardless, there is, in Helterline, no disclosure of an image forming system as recited in claim 1.

Helterline teaches that information that may be stored in memory 38 can be operational information (see col. 6, lines 1-8; col. 6, lines 51-53) or non-operational information (see col. 6, line 54-col. 7, line 21). However, nowhere in Helterline is it disclosed that memory 38 may contain user support information. Furthermore, there is no disclosure that a user is supported based on processing of reading any information contained in memory 38. Accordingly, Applicant submits that claim 1 is patentable over Helterline. Claim 3 is patentable over the cited art for analogous reasons.

As mentioned above, claims 2 and 4 have been cancelled by this Amendment.

**2. Claims 11-12, 18, 20, 22, 24, 26, 28, 32, 34, 35 and 36**

Helterline fails to disclose an image-forming system as recited in claim 11 as Helterline fails to disclose an image-forming system wherein prize data is stored in a memory element. Helterline further fails to disclose a component that reads the prize data to determine if something has been won.

As discussed above, Helterline discloses that the memory 38 can contain operational information or non-operational information. The operational information, i.e., information relating to the performance of printer 12, does not constitute prize data. Furthermore, the non-operational information does not constitute prize information, nor is there a disclosure of awarding a prize to a user based on a reading of any of the non-operational information. Helterline does disclose that credits may be awarded to a user for printing advertisements, for

example. Col. 8, lines 59, 65. However these credits are not prize data as Applicant understands the term “prize data.” Credits are awarded to a user based on printing, for example, advertisements, whereas prizes are awarded as a matter of chance based on the purchase or use of an ink cartridge. No specific act, such as printing certain advertisements, is required to be awarded a prize.

Accordingly, Applicant submits that claim 11 is patentable over Helterline for at least these reasons. As claim 12 depends on claim 11, Applicant submits that claim 12 is patentable at least based on this dependency.

For analogous reasons, Applicant submits that claims 18, 20, 22, 24, 26, 28, 32, 34, 35 and 36 are patentable over Helterline.

### **3. Claims 13, 19, 23, 27 and 31**

Helterline fails to disclose an image-forming system as recited in claim 13. Claim 13 recites an image-forming system having a prize awarding component that performs processing for awarding a prize to a user in correspondence to usage data stored on a memory element of a cartridge read by a reading component. It does appear that Helterline discloses storing usage data on memories 38 (col. 9, lines 1-12). However, there is no disclosure in Helterline that such usage data is read and a prize is awarded to a user based on the reading of this usage data.

For analogous reasons, Applicant submits that Helterline fails to disclose an image-forming system as recited in claims 19, 23, 27 and 31.

**4. Claim 37**

Helterline fails to disclose a cartridge as recited in claim 37. For example, Helterline fails to disclose a memory element for storing user information which identifies a user of an image-forming apparatus. Furthermore, there is no disclosure in Helterline of providing a benefit to a user of an image-forming apparatus based upon the storage and subsequent reading of any user information in a memory element of a cartridge. The passages of Helterline cited by the Examiner do not support the Examiner's assertions. Therefore, Applicant submits that claim 37 is patentable over Helterline.

For analogous reasons, claims 38-40 are patentable over Helterline.

**5. Claims 41-45 and 47-52**

Helterline fails to disclose a method as recited in claim 41. In the passages of Helterline cited by the Examiner, it is mentioned that certain data, e.g., statistical data used for marketing purposes, may be stored on memory 38. Col. 8, lines 29-46. It is further disclosed that this data may be passed through a suitable port to an information collection device, e.g., a computer or a microprocessor. Col. 8, lines 29-46. However, there is no disclosure in Helterline that printing environment information is sent to an information providing server. Further, there is no disclosure in Helterline of the information collection device sending any information back to the cartridge or any other element of the Helterline disclosure. Accordingly, Applicant submits that Helterline fails to disclose each element of claim 41. Thus, Applicant submits that claim 41 is patentable over Helterline.

As claims 42-45 depend on claim 41, Applicant submits that claims 42-45 are patentable over Helterline at least based on this dependency.

For analogous reasons, claims 47-52 are patentable over Helterline.

**35 U.S.C. § 103 REJECTIONS**

Claims 5-10, 16-17, 21, 25, 29, 30, 33 and 46 have been rejected as being unpatentable under 35 U.S.C. § 103(a) as being unpatentable over Helterline in view of Archer.

As an initial matter, Applicant notes that the Archer reference is non-analogous art and, therefore, cannot be used in combination with Helterline to reject these claims as being obvious. *See, e.g., Jurgens v. McKasy*, 927 F.2d 1552 (Fed. Cir. 1991) (stating that non-analogous art has no bearing on the obviousness of a patent's claims). Archer relates to a system for purchasing lottery tickets on-line and redeeming winning lottery tickets so purchased in person. One working in the field of image-forming apparatuses seeking to solve the problems associated with disposable ink cartridges not being recycled would not look to art in the field of on-line lottery ticket sales to solve this problem. Thus, Applicant submits that the Examiner has improperly relied upon non-analogous art in making his rejection. Therefore, Applicant submits that the obviousness rejections must be withdrawn for at least this reason.

However, as discussed below, even assuming that the Examiner's reliance on the Archer reference was proper, the Examiner has still failed to establish that claims 5-10, 16-17, 21, 25, 29, 30, 33 and 46 are obvious.



**1. Claim 5**

Helterline discloses a ink jet printing system as discussed above. The Examiner admits that Helterline fails to disclose an image-forming system which stores lottery determination data in the memory element of a cartridge and has a reading component, a lottery determination component and a prize awarding component as recited in claim 5. To overcome this admitted deficiency, the Examiner relies on Archer. However, the Examiner's reliance on Archer is misplaced. Even if one of ordinary skill in the art would have been motivated to combine Helterline and Archer, one would still not arrive at an image-forming apparatus as recited in claim 5.

Archer discloses a system for facilitating lottery ticket sales on line. A prospective purchaser accesses the internet and points its web browser to the website of a lottery service provider (LSP). Step S4-2 of Fig. 4A. From there, the purchaser chooses to purchase a lottery ticket, makes the relevant choices and enters the appropriate purchaser information. Figs. 4A, 4B and 4C. The LSP then generates a unique code related to the transaction and sends this code to the purchaser. Step S4-12 of Fig. 4C. This information is also stored in a database table. Step S4-13 of Fig. 4C. Should the purchaser purchase a winning ticket, the purchaser presents the unique code and other appropriate information to an authorized payment center where the information is verified and the lottery winnings are paid, if appropriate. Figs. 5A-5C.

Archer requires that a purchaser present his winning ticket to an authorized payment center in order to receive his prize. The relevant lottery data is stored at the LSP, not at the purchaser's computer. Thus, combining Archer and Helterline, one would not arrive at an

image-forming apparatus wherein lottery information is stored on a memory element of a replaceable cartridge and a lottery determination and a prize awarding determination is carried out in the image-forming apparatus.

Furthermore, the Examiner has provided no credible motivation in either Helterline or Archer to combine the two references. The Examiner states that such motivation would be driven by a desire of manufacturers to provide incentive to potential users to purchase the manufacturer's cartridge by providing the user with a potential prize via a lottery. However, such a motivation is absent from both Archer and Helterline. Indeed, such motivation comes impermissibly from the disclosure of the present application. *See, e.g., In re Gordon*, 733 F.2d. 900 (Fed. Cir. 1984) (the motivation to combine references must come from the prior art).

For the above reasons, Applicant submits that claim 5 is patentable over the combination of Helterline and Archer.

For analogous reasons, claims 17, 21, 25, 29, 30 and 33 are patentable over Helterline in view of Archer.

## **2. Claims 6-10**

As claims 6-10 each depend on claim 5, Applicant submits that claims 6-10 are patentable over the combination of Helterline and Archer at least based on this dependency.

## **3. Claim 16**

The Examiner rejects claim 16 on the basis of claim 16 having the same limitations as claim 14. However, the Examiner has not rejected claim 14 in this Office Action on any basis. Regardless, the combination of Helterline and Archer fails to render obvious claim 16. With

respect to claim 16's dependence on claim 5, claim 16 is patentable over the combination of Helterline and Archer at least based on this dependency. With respect to claim 16's dependence on claims 11 and 15, as Archer fails to cure the deficiencies of Helterline set forth above, claim 16 is patentable over the combination of Helterline and Archer.

**4. Claim 46**

Claim 46 depends on claim 45, which depends on one of claims 41-44, with claims 42-44 being dependent on claim 41. As Archer fails to cure the deficiencies of Helterline set forth above with respect to claim 41, claim 16 is patentable over the combination of Helterline and Archer.

**CONCLUSION**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

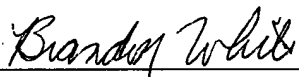
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